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In the

Supreme Court of the United States

OCTOBER TERM 1964

No. 677

THE GUIBERSON CORPORATION AND DRESSER INDUSTRIES, INC.

Petitioners,

v.

JACK C. WEBBER AND MISSION MANUFACTURING COMPANY,

Respondents.

Petition for Writ of Certiorari to the United States Court of Appeals for The Fifth Circuit and Supporting Brief

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To the Honorable, the Chief Justice, and Associate Justices of the Supreme Court of the United States:

Your Petitioners, The Guiberson Corporation and Dresser Industries, Inc., respectfully pray for Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit to review a decision of that Court rendered on July 31, 1964, in the above cause.

A copy of the opinion of that Court is included in the record filed herewith, being reported at 336 F. 2d 461.

In compliance with Rule 23 of this Court the following information, statements and arguments are presented in the order set forth in said Rule:

(a) *Reports of Decisions below:*

The Trial Court opinion is reported at 231 Federal Supplement 596. (Copy is attached; Appendix Page A-1 to 13).

The Court of Appeals opinion is reported at 336 Federal Second Series 461. (Copy is attached; Appendix Page B-1 to B-3).

(b) *Grounds of Jurisdiction:*

(I) The date of judgment of the Appellate Court is July 31, 1964 and the time of entry of the judgment is July 31, 1964.

(II) The date of the order overruling the Petition for Rehearing is September 3, 1964.

(III) The statutory provisions conferring jurisdiction on this Court are as follows:

Title 28, U.S.C.A. Sec. 1254 (1) confers jurisdiction on the Supreme Court of the United States to review decisions of U.S. Courts of Appeals by Writ of Certiorari.

Title 28, U.S.C.A. Sec. 1338 (a) gives U.S. District Courts original jurisdiction in patent infringement cases.

(c) *The questions presented:*

(I) Did the lower courts apply the standard of invention to the patent in suit required of a combination patent as laid down in the case of *Great Atlantic and Pacific Tea*

Company v. Supermarket Equipment Corp., 71 S. Ct. 127; 340 U.S. 147, (1950), and as required in Title 35 U.S.C.A. Sec. 103.

(II) Did the patentee in the patent in suit comply with the provisions of Title 35 U.S.C.A., Sec. 102 (a) (b) (e) (f) and (g) in view of the undisputed evidence.

(III) Did the patentee of the patent in suit comply with the provisions of Title 35 U.S.C.A., Sec. 103, in view of the undisputed evidence.

(IV) Are the claims of the patent in suit sufficiently definite to comply with the provisions of the Statute, Title 35, U.S.C.A., Sec. 112.

(V) Are the findings of fact of the Trial Court, adopted verbatim from Respondents' proposed findings of fact, subject to review by the Supreme Court.

(d) *Constitutional provisions and Statutes involved:*

Constitution of the United States, Art 1, Sec. 8, Cl. 8:

> "Patents and copyrights.—To promote the Progress of Science and useful Arts, by securing for limited Time to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

Title 35, U.S.C.A., Sec. 102:

> "Conditions for patentability; novelty and loss of right to patent
>
> A person shall be entitled to a patent unless —
>
> (a) the invention was known or used by others in this country, or patented or described in a printed

publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or .....

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other."

Title 35, U.S.C.A., Sec. 103:

"Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

Title 35, U.S.C.A., Sec. 112:

"Specification;

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

(e) *Statement of the Case:*

This is a patent infringement suit brought by the Respondents, Jack C. Webber (patentee) and Mission Manufacturing Company (exclusive licensee) against Petitioners for infringement of U.S. Patents 2,633,808 entitled "Well Swab" and 2,719,768 entitled "Well Tools and Sealing Means Therefor" which will be hereinafter referred to as the "808 patent" and "768 patent". (The patents are included in the record, Exhibit Vol. Pages 1 and 2).

The suit was filed on March 10, 1955 and was tried on April 11-20, 1960.

Initial findings of facts and conclusions of law were filed by the Court on March 30, 1961 wherein the Court held both the 808 and 768 patents invalid, based upon prior public use and sales of devices made in accordance with the patents in suit by the Respondents herein (Plaintiffs below).

The Court mistakenly held the 808 patent invalid on such prior use and sales because the prior use and sales were not early enough to predate the filing date of the 808 patent, as stated in the Court of Appeals Opinion.

The case was resubmitted and taken under advisement by the Trial Court for a period of approximately two years. On March 6, 1963 findings of facts and conclusions of law were entered holding Patent 808 valid and infringed, and Patent 768 invalid based upon such prior uses and sales by the Respondents.

Concerning the validity and infringement of the 808 Patent, the Court adopted verbatim the proposed findings of fact numbered I through XI (R. Vol. 5, P. 1226-32) presented by the Plaintiffs below which related to the status of the parties, the patents in suit, jurisdiction, general comments regarding the advantages of swabs made in accordance with patents in suit, the principle of operation thereof, and a general description of prior art devices, finding generally that prior art devices as so classified in Plaintiffs' proposed findings, and as adopted verbatim by the Court, operate on the principle of "the heavier the load, the tighter the seal" whereas the Webber type swabs operate on the

principle of "the heavier the load, the lighter the seal" (Findings of Fact No. 1-11 by Trial Court, Appendix P. A-1 to 8). The Court adopted verbatim Plaintiffs' Findings of fact No. XVII-XIX (Findings of Fact No. 12-14 by the Trial Court, Appendix P. A-8 to 9) (R. Vol. 5, Page 1235-36) relating to infringement anl alleged copying of the commercial form of the swab of the patents in suit. However, the Court omitted Plaintiffs' proposed findings No. XII-XVI (R. Vol. 5, P. 1232-35), relating to proposed specific findings of inapplicability of prior art patents and prior use devices relied on by the defendant, and Plaintiffs' proposed finding No. XXIII (R. Vol. 5, P. 1240) relating to commercial success of the Webber swab.

Thereby there was left a complete hiatus in the findings as to specific applicability of prior art patents and uses to the patents in suit, the Court relying wholly on generalized statements that such prior art patents and devices did not perform the function of the Webber seal.

Final judgment was filed by the Lower Court on April 19, 1963. Appeal to the Court of Appeals for Fifth Circuit was duly perfected, the case was submitted, and the Court of Appeals handed down its decision on July 31, 1964 affirming the decision by the Lower Court en toto. Petition for rehearing was duly filed by Petitioners and was overruled without opinion on September 3, 1964.

(I) The Patents in suit

The patents in suit relate to well swabs, which is a type of plunger lowered on a cable into an oil well below the

fluid therein to remove the fluid. The plunger has rubber cup, or washer-like sealing flanges disposed on the outer side thereof, which engage and seal against the wall of the well pipe, to pull fluid out of the well as the swab is retrieved from the well by pulling upwardly on the cable.

Well swabs of this type have been used for many years prior to the Webber invention.

The alleged improvement made by Webber in the patent in suit was the provision of rubber sealing flanges which are unreinforced, and when subjected to the weight of fluid thereabove, the flanges fold and stretch downwardly in an inverted position to seal against the wall of the well pipe as the swab is pulled upwardly through the pipe, and if subjected to a greater pressure than the rubber flanges can support, the flanges will flex further downwardly to allow the by-pass of the overload of fluid, and will again seal against the wall of the pipe after the overload has by-passed the flanges. The patent is drawn broad enough to cover one such sealing flange or a plurality of sealing flanges molded or otherwise attached to a support which may be disposed on the well swab.

The patent is also broad enough to cover the use of such a rubber sealing flange on any type of well tool, whether used for swabbing or not.

The basic patent No. 808 disclosed rubber sealing flanges which are straight on the edges as is any common flat wash-

er, and thus when inclined upwardly the flanges would be beveled inwardly with relation to the axis of the support on which it was mounted.

It was testified by the expert witnesses for both Plaintiffs and Defendants that such a sealing flange with beveled edges virtually represents a worn out sealing flange and that it would not lift an appreciable amount of fluid from the well (R. Vol. 3, Page 538-42 and Page 622).

To correct this mistake a new patent application was filed which resulted in the 768 patent, wherein the edges of the sealing flanges were made parallel to the axis of the swab support when the flanges were inclined upwardly in order to provide an extra wear surface on the edges of the lips (R. Vol. 2, Page 448).

All swab cups manufactured of the type covered by the patents in suit were made in accordance with the disclosure of the 768 patent.

The Trial Court found, and was sustained by the Court of Appeals, that the 768 patent was invalid by reason of prior use and sales more than one year before the application for patent was filed (R. Vol. 5, Page 1296-1297).

No commercial sale was ever made of the embodiment of the swab cup shown in patent No. 808, now under consideration, and it was apparently discarded as an inoperable device (R. Vol. 1, Page 216).

(f) *Argument:*

1. The Court of Appeals and the District Court failed to apply to the patent in suit the high standard of invention required by the Supreme Court of the United States.

In *Great Atlantic Pacific Tea Co. v. Supermarket Equipment Corp.*, 71 S. Ct. 127; 340 U.S. 147, 1950, it was held that:

> "Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements."

It was also held in that case that the question of the proper standard of invention to apply to a patent is a question of law and not a question of fact, and that the two Court rule announced in *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*, 336 U.S. 271, 69 S. Ct. 535, is not applicable.

It is Petitioners' contention that the proper standard of invention has not been applied in this case and that, therefore, the Lower Courts have rendered decisions contrary to applicable decisons by the Supreme Court of the United States.

It is without dispute in the record that the novelty claimed for the patent in suit is a sealing element, having a rubber flange or flanges thereon which will fold down in response to pressure exerted thereabove to an inverted position and will fold further downwardly upon being subjected

to a greater pressure to allow fluid to by-pass it. The Trial Court so found. (Finding No. 8, Appendix Page A-6).

The mere statement of the alleged invention in the Trial Courts finding No. 8 should be sufficient to render the patent invalid, because it is obvious without argument that rubber is inherently elastic, and that a rubber flange or washer will bend and stretch in response to pressure exerted thereagainst and will turn "wrong side out" and will dump fluid if sufficient pressure is exerted against it, and no amount of argument can raise this inherent and old function to the dignity of invention.

This alleged invention falls in the category of the ridiculous inventions listed by Justice Douglas in his concurring opinion in *The Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.* case, supra, at Page 132.

A higher standard of invention is required than the mere provision of a rubber washer which will turn over in response to pressure, which is the simplest statement of the alleged Webber invention.

Section 103 of the Patent Statute (35 U.S.C.A., Sec. 103), prohibits the patenting of inventions which are obvious at the time the invention is made to a person having ordinary skill in the art to which the subject matter pertains.

It is apparent without argument that the invention claimed in the patent in suit is obvious not only to a person having ordinary skill in the art, but to a five-year old child.

The record is replete with seal members used on well tools and swabs having unreinforced rubber flanges thereon which will turn over to seal against a pipe and will move further downwardly in response to increase of pressure thereabove to by-pass fluid.

These devices begin in 1865 with the Parham patent (Exhibit Vol. P. 175), and include the Westbrook patent, 1877 (Exhibit Vol. P. 180), Jenks patent, 1879 (Exhibit Vol. P. 171), Welter patent, 1895 (Exhibit Vol. P. 179), Rymal patent, 1940 (Exhibit Vol. P. 176), Hamilton patent, 1933 (Exhibit Vol. P. 169), the "Stick Swab" (Exhibit Vol. P. 208, 215, 217-18) used extensively since at least as early as 1921, and the Kobe seal (Exhibit Vol. P. 195-204) which was in public use and on sale in 1947, more than a year before the patent in suit was applied for.

Indeed some of these devices read directly on the specific combination claims of the Webber 808 patent.

For instance, Claim 1, which was one of the representative claims relied on by the Plaintiff in the Trial Court reads directly on the Rymal seal and Claim 15, which was the other representative claim relied on by the Plaintiffs in the Trial Court reads directly on the Stick Swab and the Kobe seal.

All of these prior patents and prior use devices were lightly passed off by the Trial Court in the sterotyped findings presented by the Plaintiffs as being either cup type or plug type sealing elements, which in reality is no distinction at all. No specific finding was made by the Trial Court that

such washer like sealing flanges, shown in the prior art, would not perform the exact function attributed to the Webber invention, or why they would not perform such function. The Court must have realized that to attempt to make such findings would have required stultification. Indeed it was admitted by Plaintiffs' expert witness that the rubber flanges on both the Kobe seal and the Stick Swab would invert and turn downwardly to seal and by-pass fluid (R. Vol. V, P. 1171, 1176-85, 1214).

The Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp. case, supra, was the last opinion by the Supreme Court of the United States elaborating on the correct standard of invention to apply.

Although the requirement of a high standard of invention was unequivocably announced by the Supreme Court as a matter of law, since the passage of the New Patent Act in 1952 considerable confusion has been evidenced in the decisions of the Courts of Appeal as to whether such high standard of invention is still required or whether Sec. 103 of the New Patent Act abrogated the decision of the Supreme Court in the *A & P* case and set a lower standard of invention.

It is respectfully urged that the instant case presents an opportunity for the Supreme Court to allay and put at rest the confusion existing in the Courts of Appeal and decide once and for all that the standard of invention laid down in the *A & P* case is still effective, and that foolish, insup-

portable patents like the one in suit should not be issued to impose a restriction on the free right of the citizenry and the business of this nation to use that which is rightfully in the public domain.

As examples of the confusion of the Courts of Appeals it has been held by the Second Circuit in *Lyon v. Bausch and Lomb* 224 F. 2d 530, (1955); *Gentzel v. Manning, Maxwell & Moore* 230 F. 2d 41 (1956) and *Riener v. I. Leon Co.*, 285 F. 2d 501 (1960), that Sec. 103 of the New Patent Act of 1952 liberalized the standard of invention laid down by the Supreme Court in the *A & P* case and that the strict standard of invention required therein was no longer applicable.

Other Courts have held that the New Patent Act does not affect or lower the standard of invention. For instance, see *application of O'Keefe*, 202 F. 2d 767 C.C.P.A. (1953) *in re Papesch*, 315 F. 2d 381 C.C.P.A. (1963), *Mojonnier Bros. & Co., Inc. v. Toland Machinery Co., Inc.* 230 F. 2d 850 C.A. 3 (1956), *Griffith Rubber Mills v. Hoffor*, 313 F. 2d 1 C.A. 9 (1963), *Welch Co. of California v. Strolee of Calif., Inc.* 313 F. 2d 923, C.A. 9 (1963).

In *Steffan et al v. Webber Heating & Sheet Metal Co.* 237 F. 2d 601 C.A. 8 (1956) and *Sterling Aluminum Products, Inc. v. Bohn Aluminum and Brass Corp.* 298 F. 2d 538, C.A. 6 (1962) it was held that the high standard of invention required by the Supreme Court is applicable despite the New Patent Act of 1952.

However, it is noted that in *Gibson-Stewart Co. v. Wm. Bros. Boiler Manufacturing Co.*, 264 F. 2d 776 (1959) the 6th Cir., although giving lip service to the high standard of invention required in the *A & P* case, refused to follow said case simply because of the difference in the complexity of the particular devices involved.

In the case of *Heyl & Patterson, Inc. v. McDowell, Inc.*, 317 F. 2d 719, C.A. 4 (1963) the Court held that the question of invention is a constitutional standard as did Justice Douglas in his concurring opinion in the *A & P* case and applied the strict standard of invention required in the *A & P* case.

In another 4th Circuit Opinion, after reviewing the decisions, the Court in *Berry Brothers Corp. v. Sigmon*, 317 F. 2d 700, C.A. 4 (1963) despaired of deciding whether the standard of patentability was the same, or was relaxed by Sec. 103 of the Patent Act of 1952, and in the end adopts the more liberal view of the 2d Circuit, expressed in *Lyon v. Bausch and Lomb* (supra).

Although the Court of Appeals for the Fifth Circuit has heretofore purported to apply the standards of invention pronounced by the Supreme Court in the *A & P* case [*Glitsh v. Wyatt*, 224 F. 2d 331 C.A. 5 (1955)] it certainly departed from this standard in the instant case by the per curiam-like opinion upholding the findings of the Trial Court.

It is respectfully urged that the decision in the instant case is in conflict with the decision of the Supreme Court in the *A & P* case and that certiorari should be granted to settle the question of the effect of Section 103 of the Patent

Act of 1952 on the standard of invention pronounced in the *A & P* case so as to relieve the uncertainty existing in the Courts of Appeal as to the proper standard of invention to apply.

The facts of this case present an excellent opportunity for the Court to settle once and for all this important Constitutional and statutory interpretation question.

2. The alleged novelty set forth in the claims of the patent in suit is presented in functional terms, and distinguished from prior art in terms of function, and therefore the sustaining of said claims by the Lower Courts is contrary to prior decisions by the Supreme Court.

The novelty of the claims of the patent in suit is dependent solely upon statements of function.

Claim 1 of the Webber 808 patent set forth below is an example of the language used in all of the claims:

> "1. A sealing member for a well tool and including,
>
> an elongate tubular body member of resilient material adopted to be mounted on the well tool and having
>
> a plurality of integral spaced resilient annular flange-like sealing rings of substantially uniform cross-sectional thickness projecting outwardly and upwardly from said body in an inverted frusto-conical shape
>
> said sealing rings being each arranged to be flexed downwardly into sealing engagement with the bore wall of the well flow conductor below a horizontal plane for sealing between said conductor and the body member

each sealing ring being arranged to support not more than a predetermined maximum fluid pressure differential

and being each further flexible downwardly out of sealing engagement with the conductor wall upon the application thereto of a fluid pressure differential in excess of said maximum pressure differential carriable by said sealing ring to permit excess fluid pressure to by-pass said ring,

and being arranged to each return to its normal inverted frusto-conical shape when relieved of any pressure differential."

It will be noted that the claim calls for a plurality of spaced resilient annular flange like sealing rings of substantially uniform cross-sectional thickness mounted on a tubular body. This is all of the structure found in the claim.

The rest of the claim beginning with "said sealing rings being each arranged" calls for the function of the sealing rings flexing downwardly to seal against the well flow conductor and flexing further downwardly out of sealing engagement with the conductor wall upon the application of a fluid pressure in excess of the pressure which the sealing flanges can carry.

This of course describes the function of any flexible rubber flange or washer.

In effect, what the patentee claims is any rubber flange-like sealing member which will turn "wrong side out" in response to pressure exerted thereagainst. This describes any and all unreinforced rubber washers and cups known and used since the discovery of the vulcanization of rubber.

Such a claim illustrates the necessity for the rule laid down in *Expanded Metal Co. v. Bradford*, 214 U.S. 36 (1909) wherein it is stated:

> "It is undoubtedly true, and all cases agree, that the mere function or effect of the operation of a machine cannot be the subject matter of a lawful patent."

The reason for the rule is clearly set forth in *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 63 S. Ct. 165 wherein it is stated:

> "* * * The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others, and the assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventors must 'inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not' * * * *"

The patentee, Webber, distinguished his claims over the prior art solely by statements of function, which is improper.

It was stated in *In Re Storsand*, C.C.P.A. (1946) 159 F. 2d 446, 449 as follows:

> "The statements in the claims as to the manner in which the apparatus of appellant operates cannot be properly relied upon to patentably distinguish his structure from that of the Allen Patent. They are functional and cannot be regarded as structural limitations or elements. In re Carr, 120 F. (2d) 386, 28 C.C.P.A. Patents 1240; In re Lamb, 146 F. (2d) 277, 33 C.C.P.A. Patents 799; Gynex Corp., et al v. Dilox

> Institute of Feminine Hygiene, Inc. et al, 2 Cir., 85 F. (2d) 103; General Electric Co. v. Wabash Appliance Corp. et al, 304 U.S. 364, 58 S. Ct. 899, 82 L. Ed. 1402."

In short the statute, 35 U.S.C.A. Sec. 112, and decisions thereunder, require that patents on apparatuses be claimed in terms of structure instead of function or the result thereof, so that the public will be informed as to the metes and bounds of the patent monopoly. See also *McClain v. Ortmayer*, 141 U.S. 419, 424 (1891), *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917), *General Electric Co. v. Wabash*, 304 U.S. 364, 369 (1938).

3. In view of the fact that the Trial Court adopted verbatim the findings of fact submitted by the Plaintiffs' Counsel such findings are subject to review by the Supreme Court.

The Trial Court adopted findings submitted by the Plaintiffs' Counsel relating to the validity of the patent in suit, without change. Therefore, the findings were mechanically adopted by the Trial Court.

In accordance with the holding of the Supreme Court in *United States v. El Paso Natural Gas Co.*, 84 S. Ct. 1044, 1047 (1964) such findings are subject to review by the Supreme Court.

The Court in that case stated:

> "Moreover, these detailed findings were 'mechanically adopted' to use the phrase of the late Judge Frank in United States v. Forness, 2nd Cir. 125 F. (2) 928,942 and do not reveal the discerning line of decision of the basic issue in the case. On review of the record, — which

> is composed largely of undisputed evidence, — we conclude that 'the effect of such acquisition may be substantially to lessen competition within the meaning of the Sec. 7 of the Clayton Act."

The adoption of the "canned" findings in the instant case illustrates the danger of such practice. A patent has been sustained which is ridiculous on its faces, and if it had been examined by the Lower Courts with the care required by the *A & P* case it would have been declared invalid in the Trial Court.

Wherefore, your Petitioner prays the allowance of its foregoing Petition for Writ of Certiorari, for the reasons herein stated.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Two copies of the foregoing Petition for Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit and Supporting Brief have been served on Respondents' Counsel by first class air mail, postage prepaid, addressed to Mr. Joe B. Edwards and Mr. Ralph R. Browning at their respective addresses of record on this ..... day of November, A.D., 1964.

Attorney for Petitioners

In the

United States District Court

FOR THE SOUTHERN DISTRICT OF TEXAS HOUSTON DIVISION

Civil Action No. 8809

JACK C. WEBBER, AND
MISSION MANUFACTURING COMPANY,
Plaintiffs,

v.

THE GUIBERSON CORPORATION,
Defendant.

Browning, Simms & Hyer (Ralph Browning), 3400 Montrose Boulevard, Houston, Texas; Vinson, Elkins, Weems & Searls (Joe E. Edwards), First City National Bank Building, Houston, Texas; for plaintiffs;

Howard E. Moore, 1400 Davis Building, Dallas, Texas; Turner, Rodgers, Winn, Scurlock & Terry (George S. Terry and Frank J. Scurlock), 2400 Republic National Bank Building, Dallas 1, Texas; for defendant.

FINDINGS OF FACT AND CONCLUSIONS OF LAW

FINDINGS OF FACT

1.

Plaintiff Jack C. Webber of Corpus Christi, Texas, is t[illegible] owner of the entire right, title and interest in and to

Webber Patent No. 2,633,808 issued April 7, 1953, entitled "Well Swab" (hereinafter referred to as the 808 patent), and in and to Webber Patent No. 2,719,768 issued October 4, 1955, entitled "Well Tools and Sealing Means Therefor" (hereinafter referred to as the 768 patent).

2.

Plaintiff Mission Manufacturing Company of Houston, Texas, is the exclusive licensee of Jack C. Webber and holds the exclusive right to manufacture, use and sell the inventions of the 808 and 768 patents. Mission manufacturers and sells well swabs identified as "Mission E-Z" (Pl. Ex. 5) under the license (Pl. Ex. 43).

3.

Defendant Guiberson Corporation of Dallas, Texas, maintains a regular established place of business in Houston, Texas, and has sold throughout the Southern District of Texas and elsewhere well swabs identified as "Simplex" Swab Cups (Pl. Ex. 8) and "Multi-wing" Swab elements (Pl. Ex. 7).

4.

A well swab is a device which is lowered on a wire line or cable into a well pipe containing a column of liquid. During lowering, the swab does not seal with the bore of the pipe and liquid is thereby allowed to bypass the device. When the swab is below the desired volume of liquid, the wire line is reeled in at the surface to raise the swab. Dur-

ing raising, the swab element moves into sealing engagement with the wall of the pipe, whereby the liquid thereabove is trapped and is lifted to the surface and thereby removed from the well pipe. Swabbing of liquids from wells is usually carried out in well completion operations to cause the well to flow although it is used for other purposes.

5.

Prior to the granting of the Webber Patents-in-suit, there were two general types of well swabs in use, the cup-type and the plug-type.

The cup-type is the most popular and consists of an upwardly directed cup of rubber or elastic material. When the upwardly directed cup has been lowered under a column of liquid, it is raised and the load expands the cup radially into tight sealing engagement with the wall of the well pipe whereby the liquid thereabove is lifted. Because the liquid is acting to increase the sealing effectiveness of the swab cup, this type of cup operates on the principle of "the heavier the load, the tighter the seal." Examples of the cup-type swab are Plaintiffs' Exhibits 39 and 40 and Defendant's Exhibits 56, 57 and 58.

The plug-type swab is one which is constructed to form a solid plug and fill the well pipe during the raising operation. A plug-type may take several different forms. It may be a solid body of rubber material which under load is radially expanded into sealing position; it may be a body which is split vertically as exemplified by Mission's split

swab (Pl. Ex. 52); or it may be a multi-piece plug consisting of a back-up member having resilient washers supported thereon as shown by the "Stick Swab" (Def. Exs. 1, 14, 26, 47, 49). But regardless of physical form, all plug-type swabs are specifically designed to substantially fill the bore of the well pipe when a liquid load is acting thereon, and since the liquid load is depended upon to flatten the plug and thereby deform it radially into sealing position, the plug-type swabs operate on the same principle as the cup-type, that is, "the heavier the load, the tighter the seal."

Because both cup-type and plug-type swabs operate on the same principle of "the heavier the load, the tighter the seal," both types may be overloaded if the swab is beneath too much fluid; further, such swabs are subject to excessive wear and have a strong tendency to stick or hang-up during lifting. Also, because the swabs must be deformed in a radial direction in order to effect a seal, the clearance between the swab and pipe during lowering is held to a minimum and difficulty is experienced in lowering the swab through restrictions in the pipe. The cup-type swab has the further inherent disadvantage of completely inverting and failing under heavier loads if it is not properly reinforced and braced.

6.

Defendant has been engaged in the manufacture of well swabs since the early 1920's and is the foremost leader in

the swabbing industry. Its engineering and research staff has made numerous developments in this field and it is the owner of many patents (Pl. Ex. 76) in the well swab field. Throughout the years, Defendant has featured the cup-type swab and has directed all of its efforts to provide reinforcing and bracing in the form of wires, sleeves, collars, inserts and ribs for the purpose of preventing the cup element of the swab from inverting under load. This reinforcing and bracing has effectively prevented the cup element from inverting and thereby failing but it has not overcome the other problems of overloading, excessive wear, tendency to stick or "hang-up" during lifting and difficulty in lowering. Defendant never manufactured any swab operating on the principles of "the heavier the load, the lighter the seal" as taught by the patents-in-suit until after it learned of Plaintiffs' swab.

7.

The problems of overloading, excessive wear, tendency of sticking by reason of restrictions, sand conditions and the like and difficulty in lowering have been present in the industry for at least thirty years prior to the Webber inventions. These problems caused breakage of the line or cable, loss of swabs and in many instances, required the well pipe or tubing to be removed from the well at substantial cost and expense; in some instances, the sticking of a swab may result in total loss of the particular well.

Throughout the years, attempts have been made to solve certain of these problems and Defendant here was cognizant of the overload problems and attempted to solve the same by manufacturing mechanical overload devices. The *Mission split swab and the stick swab are examples of attempts to solve the problem of difficulty in lowering.* However, because all swabs, prior to the Webber inventions, operated on the principle of "the heavier the load, the tighter the seal," no solution was provided for the problem of excessive wear or for the problem of sticking or hanging-up during the lifting operation. And the industry lived with the problems and suffered the economic consequences thereof.

8.

It was in this state of the art that Plaintiff Webber conceived the swab disclosed and claimed in the patents-in-suit. The Webber swab consists of a swab element having a plurality of elastic sealing rings which are so constructed and related to the well pipe that during lowering each sealing ring does not seal with the pipe to permit free bypass of liquid; upon raising, the liquid load acts upon the ring to move the same downwardly to a trailing position and while in such trailing position said ring engages the well pipe to properly seal and carry the required liquid load; in case of overload each ring may move farther downwardly to automatically bypass liquid until the overload condition is relieved after which the ring again returns to load-carrying position.

The Webber swab operates on an entirely new principle as compared to prior known swabs in that the imposition of increased load beyond that which the ring can carry tends to move the ring toward a non-sealing position. In the Webber swab, the operating principle is "the heavier the load, the lighter the seal" which is directly opposed to the operating principle of the prior swabs.

9.

The Webber swab effectively solved the major problems which had been long-existent in the swabbing art. By reason of its structure and relationship to the pipe, overloading because of excessive liquid, sanding conditions or for other reasons is not possible. Excessive wear is reduced because the liquid load is not functioning to urge the sealing element into tighter engagement with the pipe wall. The unreinforced swab lips provide the necessary flexibility to facilitate its lowering in restrictions such as paraffin, scale or tight spots in the tubing. And, finally, it is not expanding in diameter, in the manner of the prior known swabs, as it is raised and the tendency of sticking or "hanging-up" during lifting is substantially eliminated. The Webber swab, as disclosed and claimed in the patents-in-suit, constituted a major step forward in the swabbing art.

10.

The first Webber 808 patent discloses the well swab having the periphery of its sealing rings beveled or inclined inwardly. This physical form operates in accordance with

Webber's basic concept. The Webber 768 patent discloses the periphery of each sealing ring as cylindrical, that is, parallel to the axis of the device. This modification of shape provides additional wear surface on each sealing ring which increases the wear life of the swab and constitutes an improvement upon the structure shown in the 808 patent. The physical structure of both the 808 and the 768 patents operate on Webber's basic principle of "the heavier the load, the lighter the seal," and both produce the improved practical advantages never before attained in the art.

11.

During the prosecution of the Webber patents-in-suit through the Patent Office, the Patent Office considered prior devices such as well packers, pump plungers, separator devices and well swabs (Pl. Exs. 3a and 4a). Thees are the same classes of devices upon which Defendant relies and are no more pertinent than the prior art which the Patent Office considered during action on the Webber patents and over which the Patent Office allowed the claims here in suit.

12.

The Simplex swab cups (Pl. Ex. 8), manufactured and sold by Defendant are of substantially the same structure, operate in substantially the same way as the swabs disclosed and claimed in the Webber patents-in-suit and produce the same practical advantages. The "Simplex" swab cups singularly and in combination wih a supporting man-

drel clearly correspond element for element with Claim 1 and 4 through 15 of the 808 patent. Defendant's admissions establish this to be the fact.

13.

The "Multi-wing" swab (Pl. Ex. 7), manufactured and sold by Defendant, is of identical construction to the structure shown and functions in exactly the same manner of the swab disclosed and claimed in the patents-in-suit and produces the same practical advantages. The "Multi-wing" swab elements singularly and in combination with a supporting mandrel clearly correspond element for element with Claims 1 and 4 through 15 of the 808 patent. Defendant's admissions establish this to be the face.

14.

Shortly after Defendant became aware of the swab disclosed and claimed in the patents-in-suit, Defendant proceeded to design the "Simplex" swab which has been offered for sale since that time. Although satisfactory to an extent, Defendant's customers demanded that Defendant produce a swab like the Mission "E-Z" swab (Pl. Ex. 71) which is the commercial swab constructed in accordance with the disclosure and claims of the patents here in suit. By reason of the pressure of customer demand and repeated insistence by Defendant's sales force, Defendant willfully and deliberately copied the commercial form of the swab of the patents-in-suit. The comparative dimensions of Plaintiffs' commercial swab and those of Defendant's

"Multiwing" swab (Pl. Ex. 64) conclusively establish that Defendant exactly copied Plaintiffs' commercial form. The physical exhibits (Pl. Exs. 7, 73) further establish that Defendant's swab is such a close copy of Plaintiffs' swab that it is difficult to tell them apart.

15.

The application for the 768 patent was filed over four years after the application for the 80[illegible] patent.

16.

All Webber sealing devices, beginning with the first experimental model made by Murray Rubber Company in December, 1948 were made in accordance with the disclosure of the 768 patent including the cylindrical edge and extra wear surface.

17.

Beginning on December 2, 1949, and extending through June of 1950, Jack C. Webber sold 37 swab cups made in accordance with the 768 Patent to Rhea Brooks Supply Company of Kilgore, Texas, who in turn sold same to Shell Oil Company, Kilgore, Texas. Shell Oil Company used said swab cups in swabbing their wells during such period.

18.

Jack C. Webber sold 15 of said swab cups during such period to Basin Supply Company of Midland, Texas (on April 29, 1950), which swab cups were used by Stanolind Oil & Gas Company in swabbing their wells in West Texas.

19.

Beginning on October 10, 1950, and extending through October 15, 1951, Mission Manufacturing Company, Plaintiff herein, and licensee under the Webber Patents, by nine separate sales, sold a total of 192 swab cups made in accordance with the 768 Patent to Shell Oil Company which were used by Shell Oil Company in swabbing their wells in East Texas.

20.

The sale of said swab cups by the Plaintiffs, Jack C. Webber and Mission Manufacturing Company, and the resale thereof by Rhea Brooks Supply Co. and Basin Supply Co., and the use thereof by Shell Oil Co. and Stanolind Oil & Gas Co., constituted public use and sale of devices made in accordance with the 768 Patent, more than one year before the patent was applied for.

The above testimony relating to prior use and prior sales is undisputed and therefore established convincingly by clear, cogent and satisfactory proof so that it removes all reasonable doubt that there was a prior public use and many sales made more than one year before the application for the 768 Patent was filed.

Section 102, Title 35, U.S.C.A. reads as follows:

> "A person shall be entitled to a patent unless —
>
> (b) the invention was patented or described in a printed publication in this or a foreign country *or in public use or on sale* in this country, more than one year prior to the date of the application for patent in the United States, or" (emp. supp.)

It then became incumbent upon the patentee to show that such use was experimental *only*. See *Merrill v. Builders Ornamental Iron Co.*, (1952), 197 F. 2d 16.

The Plaintiffs herein have failed to sustain this burden. Here, as in *Rosaire v. Baroid Sales Division, National Lead Co.*, 218 F. 2d 72, (5th Cir.), cer. den. 349 U. S. 916, such use was not "an unsuccessful or incomplete experiment." At all times the design was substantially the same. The only problem was in the quality of the rubber used. This prior use and the prior sales were such an anticipation as to render the 768 Patent invalid. It is therefore unnecessary to consider the questions or contentions pertaining to patentability or infringement of the 768 Patent.

The Supreme Court of the United States has gone so far as to hold that the public use by *one* person of an invention is sufficient to condemn it. *Egbert v. Lippmann*, 104 U.S. 333, 336, 26 L.Ed. 755:

> "We remark, secondly, that whether the use of an invention is public or private does not necessarily depend upon the number of persons to whom its use is known. If an inventor, having made his device, gives or sells it to another, to be used by the donee or vendee, without limitation or restriction, or injunction of secrecy, and it is so used, such use is public, even though the use and knowledge of the use may be confined to one person."

To the same effect see *Application of Blaisdell*, 242 F. 2d 779, 784 (U.S. Ct. of Cr. and Patent Appeals 1957) and cases therein cited.

CONCLUSIONS OF LAW

1.

This Court has jurisdiction of the parties and the subject matter of this suit.

2.

The prior art cited by Defendant does not anticipate Claims 1 and 4 through 15 of Webber Patent No. 2,633,808.

3.

Claims 1 and 4 through 15 of Webber Patent No. 2,633,-808 are valid.

4.

The clear unambiguous language of Claim 1 and 4 through 15 of Webber Patent No. 2,633,808 is applicable to the "Simplex" and "Multi-wing" well swabs manufactured and sold by Defendant and Claims 1 and 4 through 15 of this patent infringed by these structures.

5.

An injunction shall issue enjoining Defendant from further infringement of Patent No. 2,633,808 ad Defendant shall be ordered to account for damages suffered by Plaintiffs.

6.

Claim 5 of the 768 Patent is invalid and void because anticipated by prior use and prior sales.

7.

From what has been said above, judgment must be for Plaintiffs on the 808 Patent and for Defendant on the 768 Patent.

Clerk will notify counsel.

/s/ ALLEN B. HANNAY

Done at Houston, Texas
this 6th day of March, 1963.

In the

United States Court of Appeals

FOR THE FIFTH CIRCUIT

No. 20655

THE GUIBERSON CORPORATION AND DRESSER INDUSTRIES, INC.,

Appellants-Appellees,

versus

JACK C. WEBBER AND MISSION MANUFACTURING COMPANY,

Appellees-Appellants.

(AND REVERSE TITLE)

Appeals from the United States District Court for the Southern District of Texas.

(July 31, 1964.)

Before HUTCHESON and RIVES, Circuit Judges, and GROOMS, District Judge.

HUTCHESON, Circuit Judge: This is a hard fought patent case involving two patents, basic patent Webber No. 2,633,808, hereafter called 808, and improvement

patent, Webber No. 2,719,768, hereafter called 768. Long and exhaustive briefs have been written, the district judge has written full, and, in our opinion, correct conclusions of fact and law, and these appeals are from a judgment declaring patent No. 808 valid and infringed and patent No. 768 invalid by reason of plaintiffs' own experimental sales.

After an eight day trial, followed by filing of briefs and oral argument, the district court filed its initial findings and conclusions of law, finding patent No. 808 valid and infringed and inadvertently finding both patent No. 808 and patent No. 768 invalid by reason of appellees' own experimental sales, although such sales did not occur prior to the September, 1948, filing day of such basic patent.

Upon this inadvertence being called to the attention of the court, the case was resubmitted and was fully and thoroughly reconsidered for a period of approximately two years. On March 6, 1963, findings of fact and conclusions of law [1] supporting a judgment as to validity and infringement of the basic Webber patent No. 808 and as to the invalidity of patent No. 768 were filed and judgment accordingly was entered.

Defendants-appellants have taken an appeal from the judgment holding Webber patent No. 808 valid and infringed, and plaintiffs-appellees Webber and Mission Mfg. Co. have appealed from the judgment declaring improvement patent No. 768 invalid by reason of appellees' prior experimental sales.

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[1] . . . F. Supp. . . .

We are of the clear opinion that the findings and conclusions and the judgment of the district judge as to both patents are correct and should be affirmed. Without, therefore, undertaking to set the findings and conclusions out, we find it sufficient to refer to them as set out in the reported opinion, note 1 *supra*, and, approving them as to each patent, we affirm the judgment as to each patent.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No. 677

THE GUIBERSON CORPORATION AND DRESSER INDUSTRIES, INC., *Petitioners,*

v.

JACK C. WEBBER AND MISSION MANUFACTURING COMPANY, *Respondents*

BRIEF FOR RESPONDENTS OPPOSING PETITION FOR WRIT OF CERTIORARI

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BRIEF FOR RESPONDENTS OPPOSING PETITION FOR WRIT OF CERTIORARI

To The Honorable The Chief Justice and Associate Justices of The Supreme Court of the United States:

This is an ordinary patent case involving Webber Patent No. 2,633,808, entitled "Well Swab" (R. Ex. Vol. p. 1).

There are no conflicting decisions of different circuits on this Webber patent. There is no important or unsettled question of Federal Law raised in the Petition which requires decision by this Court.

Petitioners have not presented any ground which justifies the granting of the Petition.

AS TO THE ALLEGED QUESTIONS PRESENTED

Petitioners set forth five questions upon which review is sought. These questions are the *same* as those which were urged before both the Trial Court and the Court of Appeals. Therefore, they constitute a request that this Court review an ordinary patent case in which the usual issues of invention and infringement have been decided. As this Court stated in *Keller v. Adams-Campbell Co.*, 264 U.S. 314, 319 (1924):

> "Such an ordinary patent case with the usual issues of invention, breadth of claims and non-infringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent."

In *Layne & Bowler Corp. v. Western Well Works, Inc., et al.*, 261 U.S. 387, 393 (1923), the Supreme Court held that the writ of certiorari should not be granted:

> "* * * except in cases involving principles, the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the Circuit Courts of Appeal. * * *"

Petitioners assert that the evidence was "undisputed", but such assertion finds no support in the record. On the contrary, the critical issues were decided upon disputed evidence as to the structure, operation and function of many prior art devices which were relied upon by Petitioners at the trial (R. Ex. Vol. Ex. 7-18, 21-27, 59 and 72-77). The lower courts resolved the disputed facts in favor of Respondents.

AS TO THE STATUTES INVOLVED

There is no reason for the Supreme Court to consider in this case Sections 102, 103 and 112 of Title 35 because the courts below have not decided any question with respect thereto.

Furthermore, Petitioners have confused the "standard of invention" rule, as pronounced by this Court in the *A & P* case,* with the "conditions for patentability" requirements of Sections 102 and 103. These sections, by their very words, assume an invention has been made and relate solely to whether or not the invention is patentable. As distinguished from this, the "standard" laid down relates only to whether or not a device constitutes an invention.

There is nothing in the present record to support Petitioners' assertions that the courts below did not apply the proper "standard" of invention or that the invention did not meet the conditions for "patentability" as required by Sections 102 and 103. As is hereinafter shown, Section 112 supports the decision reached in the case.

SUMMARY OF LOWER COURTS' OPINIONS

Respondents brought suit charging Petitioners with infringement of Webber Patent No. 2,633,808. The patent relates to a particular well swab. The Court of Appeals unanimously affirmed the Trial Court, holding the patent valid and infringed. There is no conflict of decision involving the patent.

Upon the evidence presented, the Trial Court entered detailed findings, which found that the problems solved

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*The Great Atlantic and Pacific Tea Company v. Supermarket Equipment Corporation, 71 S.Ct. 127 (1950)

by the Webber swab had existed for thirty years and that others, including Petitioners, had attempted but failed to solve the problems (F.F. 7; R. 1291-2); that the Webber swab operates on an entirely new principle as compared to prior swabs (F.F. 8; R. 1292-3) and that the Webber swab solved the long-existent problems and was "a major step forward in the swabbing art" (F.F. 9; R. 1293).

The Court of Appeals* recognized the case as a "hard fought patent case" in which "long and exhaustive briefs" were submitted. Its opinion points out that "The district judge has written full, and, in our opinion, correct conclusions of fact and law." The opinion establishes that the record was fully reviewed since the history of the case is set forth followed by the Court's holding that:

> "We are of the clear opinion that the findings and conclusions and the judgment of the district judge as to both patents are correct and should be affirmed."

The Court of Appeals' opinion refutes Petitioners' statement that it is a "per curiam-like" opinion. Where the trial court has entered detailed findings of fact fully supporting its conclusions and judgment, there is no need for the appellate court to repeat, as the Court of Appeals stated, by "undertaking to set the findings and conclusions out". The Court of Appeals reviewed the record and affirmed. It followed proper appellate practice.

AS TO PETITIONERS' ARGUMENT

Answering Point 1

Petitioners erroneously assert that the lower courts failed to apply the "high standard of invention" required by the

*Opinion reported at 336 F.2d 461 (1954)

Supreme Court in the *A&P* case, supra. However, there is no support in the Petition or in the record for this assertion, and it is a mere *assumption* on Petitioners' part.

The Petition *admits* that the Fifth Circuit Court of Appeals has applied the standard of invention pronounced by the Supreme Court in the *A & P* case, citing *Glitsch v. Wyatt*, 224 F.2d 331, CA 5 (1955). Actually, the Fifth Circuit Court of Appeals has consistently applied such standard and has established the same as the law of this circuit. *Ritchie v. Lewis*, 196 F.2d 434; *Graham v. Jeoffroy*, 206 F.2d 769; *Cornell v. Adams Eng. Co.*, 258 F.2d 874; *Robinson v. DiGaetano*, 212 F.2d 1; *Clark v. Murray*, 219 F.2d 313; *Jeoffroy v. Graham*, 219 F.2d 511.

There is nothing in the opinion of the Fifth Circuit Court of Appeals to support the bare assertion that it departed from its own precedent in applying the proper standard of invention.

The authorities cited by Petitioners at pages 13-15, which refer to decisions in other circuits, are not pertinent to the question of whether or not the Fifth Circuit Court departed from its own precedent.

The Trial Court's detailed findings and conclusions—affirmed by the Appeals Court—clearly demonstrate that the proper standard of invention was applied.

Petitioners erroneously state that, "It is without dispute that the novelty claimed for the patent in suit is a sealing element" having a rubber flange or flanges which fold down in response to pressure. And, say Petitioners, the "trial court so found", citing Finding 8 (Appendix p. A-6, Petition). A consideration of Finding 8 shows this statement to be without substance because said Finding defines

the Webber swab as something more than a rubber flange which folds down; it brings out the *relationship* of each sealing ring of the swab to the particular well pipe in which it is used, refers to the trailing or inverted position of each sealing ring while carrying its liquid load and sets forth the automatic by-pass under overload. It is the overall combination which causes the Webber swab to operate "on an entirely new principle", and Petitioners carefully ignore any reference to such combination.

Petitioners assert that the invention falls into the category of the "ridiculous" inventions listed by Justice Douglas in his concurring opinion in the *A&P* case, supra, but this assertion finds no support in the record. On the contrary, the invention is a valuable and necessary well tool which was perfected and brought to market only after many years of experimental work (R. 46, 145-148, 150, 159, 397; Ex. Vol., PX 54, 55, 56, pp. 76, 90, 109). It was a commercial success (R. 293, 325, 327, 338) because it effectively solved the major problems which had been existent for "at least thirty years" (F.F. 7; R. 1291). It constituted, as the lower courts agreed, a "major step forward in the swabbing art" (F.F. 9; R. 1293).

Answering Point 2

Petitioners' arguments that the claims are functional were repeatedly urged before the Trial Court and again before the Court of Appeals. These argument were rejected when the Trial Court found that "The Webber swab, as disclosed and *claimed* in the patents-in-suit, constituted a major step forward in the swabbing art". (F.F. 9; R. 1293) (emphasis added). The Court of Appeals agreed.

The authorities cited by Petitioners in support of their argument that the claims are functional are not pertinent since they are all prior to 1952, the effective date of 35 U.S.C. § 112. This section specifically provides that an element may be expressed as a means for performing a specified function, and the pertinent portion is as follows:

> "An element in a claim for a combination *may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof,* and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." (emphasis added)

Therefore, even if it be assumed that some functional statements are included in the claims, the claims meet statutory requirements. The lower courts' opinions are in conformity with section 112 and Petitioners' assertions are without merit.

Answering Point 3

Petitioners take the untenable position that because the Trial Court adopted findings submitted by counsel, such findings should be reviewed by the Supreme Court. Petitioners rely upon *United States v. El Paso Natural Gas,* 376 U.S. 651. Such case is distinguishable because the record was "composed largely of undisputed evidence", whereas in the present litigation, the evidence presented by each party as to the prior art devices—and particularly as to the type, structure, function and operation of prior art swabs—was in direct conflict. The conflict was resolved in favor of Respondents.

Furthermore, the record reflects that the District Court did not merely "mechanically adopt" findings, but instead carefully studied all proposed findings of *both* parties. The District Court then adopted some of Respondents' proposed findings, some of Petitioners' proposed findings, at least one of Petitioners' findings with modifications, and then added findings in the form of comments composed and written by the court itself.

It is interesting to note that Respondents proposed a total of 23 findings and 11 conclusions of law (R. pp. 1226-1246); Petitioners proposed a total of 55 findings and 10 conclusions of law (R. pp. 1243-1260). The comparison of these findings to the District Court's final 20 findings (including some of its own) and 7 conclusions (also at least one of its own) establishes beyond question that there was no "mechanical adoption" of stereotyped findings by the District Court in this case.

Additionally, the courts have recognized that in complex and technical patent cases, the assistance given the trial court by the submission of proposed findings is almost indispensable. As was said in *Louis Dreyfus & Cie v. Panama Canal Company*, 298 F.2d 733 (5 Cir. 1962):

> "* * * This assistance may be especially helpful in a case involving complex and technical subject matter, as in patent cases, where the aid of a specialist may be but a shade short of indispensable. In such cases it might be assumed that the trial judge considered the case from all angles and reached his decision independently *before* placing reliance on the proposed findings. * * *"

Here, the proposed findings served to assist the trial judge who, after full consideration, selected some from

the Respondents, some from the Petitioners and prepared some of his own. There is no support in the record for the position taken by Petitioners.

CONCLUSION

The Petition asserts no conflict of decisions as to the Webber patent, and no important question of Federal Law which requires decision by this Court is raised. The Petition is, in effect, a request for this Court to review an ordinary patent case between private parties. The Petition is without merit, in fact and in law, and should be denied.

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Of Counsel:

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J. VINCENT MARTIN
M. H. GAY

CERTIFICATE OF SERVICE

A copy of the foregoing Brief for Respondents Opposing Petition for Writ of Certiorari has been served on Petitioners' counsel by first class air mail, postage prepaid, addressed to Frank J. Scurlock and Howard E. Moore at their respective addresses of record on this _____ day of December, 1964.

Counsel for Respondents